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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,487	11/07/2000	Mitta Suresh	28122.52	9609

27683 7590 03/14/2003

HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER

THANH, LOAN H

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/707,487	Applicant(s) SURESH ET AL. <span style="float: right;">Ch</span>	
	Examiner LoAn H. Thanh	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 19-27 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 19-27 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4-6</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election of species E/ of fig. 7d in Paper No.10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant is reminded that upon allowance of a generic claim, the applicant is entitled to consideration of claims to additional species which are written in dependent or otherwise include all the limitations of an allowed generic claim. See paper no. 7, page 4. Further, since applicant is traversing on the ground that the species are not patentably distinct, applicant should have submitted evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

The Examiner is not in agreement that all the independent claims are generic to all the species. See figs. 7 a-c. There is no collapsible lumen in all the embodiments.

An action on the merits now follows.

***Priority***

The Examiner is acknowledging that this application is a CIP of application number 09/204,108, now patent number 6,179,827.

### ***Information Disclosure Statement***

The information disclosure statement filed 02/05/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

The drawings are objected to because it is unclear in Fig. 3 why the end of sleeve 40 is closed off. In fig. 7d, "726" is not supported in the specification. It is unclear in the drawings what the hollow support member is. There is no element number shown.

Correction is required.

### ***Specification***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement

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invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because there is a lack of enablement as shown in Fig. 3. It is unclear how fluid can be delivered to expand the sleeve member (40) if the sleeve is closed at the distal end of the transition (82). It appears that no fluid would be delivered past the termination of the transition (82) portion. It is unclear whether this is just a drawing error or a different embodiment. It is the understanding of the Examiner that Fig. 3 is just an expanded version of the device in Fig. 2 (which is the deflated form).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no support for the collapsible lumen t to be collapsed inside the catheter body. (see claims 2, 20) It is the Examiner's interpretation that the lumen is collapsed onto the catheter body.

The disclosure is objected to because of the following informalities: Applicant is requested to update the status of the patent to which applicant is claiming a priority. *ok*  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4,7,8-9,21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the nozzle" in line 2. There is insufficient antecedent basis for this limitation in the claim. There is support for "the nozzle" in claim 3.

Claim 7 recites the limitation "the nozzle" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is support for "the nozzle" in claim 3.

Claim 8 recites the limitation "the openings " in line 1. There is insufficient antecedent basis for this limitation in the claim. There is support for "the openings" in claim 5.

Claim 22 recites the limitation "the nozzle" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is support for "the nozzle" in claim 21.

Claim 23-24 recite the limitation "the plurality of openings " in line 1. There is insufficient antecedent basis for this limitation in the claim. There is support for "the openings" in claim 21.

Claim 25 recites the limitation "the nozzle" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is support for "the nozzle" in claim 21.

Claim 26 recites the limitation "the openings " in line 1. There is insufficient antecedent basis for this limitation in the claim. There is support for "the openings" in claim 21.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13,19-27,35,37 are rejected under 35 U.S.C. 102(b) as being anticipated by Macoviak (U.S. Patent No. 5,738,649)

See figs. 1-5 and cols. 8-9.

Claims 1-2,4-6,12,13, 19,20, 22-23,35-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Abiuso et al. ( U.S. Patent No. 5,213,576).

Abiuso et al. disclose a catheter having a catheter body, at least one collapsible lumen (balloon 26 or 28). The balloon member/ dilator is considered the second balloon ( 26 or 28).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14, 19-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,179,827. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elements of the because the application claims are a broader recitation of the invention than that of the issued patent, including all of the same limitations. The claims of the application claim a catheter body, and collapsible lumen. The patent claims recite a catheter body, a collapsible member. Since a broad interpretation of member includes a collapsible lumen, if a patent was to grant on the pending claims of this application applicant would be granted an unlawful extension of protection beyond the years of the 6,179,827 patent.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038. The examiner can normally be reached on Monday to alternating Fridays (7:00 am-4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



LoAn H. Thanh  
Examiner  
Art Unit 3763

LT  
March 10, 2003